

REMARKS

Claims 28-31, 33-36, 38-54, and 58-61 were pending in the application. By this paper, Applicant has cancelled Claims 30 and 38 without prejudice, and amended Claims 28, 36, 40, 44, 45, 51, 54, and 59-61. Accordingly, Claims 28, 29, 31, 33-36, 39-54 and 58-61 are presented herein for examination.

§112 Rejections

Per page 2 of the Office Action, Claims 28-31, 33-36, and 38 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner alleges that (1) the originally filed application does not disclose first and second rows of spools offset from one another in at least two dimensions as recited in Claim 28, line 14 and Claim 35, line 2; and (2) that the originally filed application does not disclose an offset (of the rows of spools) permitting the depth of the housing to be less than the sum of the diameter of two of the spools as recited in Claim 36. Applicant addresses these two grounds of rejection in turn.

Claims 28 and 36 – Applicant has herein amended Claims 28 and 36 to delete the phrase “in at least two dimensions” thereby rendering the Examiner’s rejection moot. Applicant submits that these claims as amended satisfy the written description requirement of 35 U.S.C. 112 as it applies to Item (1) above.

Regarding Item (2) above (applicable to dependent Claim 36 only), Applicant respectfully traverses the Examiner’s 112 rejection. Specifically, Applicant asserts that Claim 36 is fully supported by the specification as filed. Applicant submits that Fig. 9 as filed clearly conveys to one of ordinary skill in the art, that Applicant was in possession of an arrangement of the spools which permitted the depth of the housing to be less than the sum of the diameter of two of the spools. Fig. 9 clearly shows the two rows offset from one another, and a necessary and inherent consequence of such offsetting is *permitting* the depth of the housing to be less than the sum of the diameter of the two spools.

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Further, Applicant believes that a skilled artisan, relying on Fig. 9 and its accompanying disclosure clearly would understand how to make and use the invention disclosed in Claim 36. Applicant respectfully submits that Claim 36 is clearly supported by the specification as filed, and hence overcomes the Examiner's 35 U.S.C. 112 rejection.

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Per page 3 of the Office Action, Claims 28-31, 33-36, 38, 40-43, 45-50, 54, 60, and 61 stand rejected as being indefinite. Various grounds for this 35 U.S.C. 112, second paragraph were given by the Examiner, and Applicant addresses each of these grounds in turn, specifically:

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Claims 28 and 36 – As previously discussed, Applicant has deleted the phrase “in at least two dimensions”, thereby rendering the Examiner's indefiniteness rejection for Claims 28-31, 33-36 moot. Applicant also notes that Claims 30 and 38 have been cancelled without prejudice.

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Claim 40 – Applicant has herein amended Claim 40 to read in relevant part, “curling at least a portion of said ribbon”. Applicant submits that Claim 40 as amended makes the phrase “said at least portion” proper, hence Applicant submits that Claims 40-43 as amended overcome the Examiner's rejection.

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Claim 45 – Applicant has herein amended Claim 45 to more clearly and succinctly describe what Applicant regards as their invention. Specifically, Applicant has deleted the use of the term “turns” and has instead utilized the phraseology “radius associated with said curl”. Applicant submits that Claim 45 as amended is fully supported by the specification as filed and overcomes the Examiner's rejection.

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Claim 54 – Applicant has herein amended Claim 54 to replace the term “spindle elements” with the term “end-receiving elements”. Support for this amendment is replete throughout Applicant's specification, including *inter alia* page 23, lines 4-6 of the specification as filed. Applicant submits that Claim 54 as amended clearly conveys to one of ordinary skill that

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the recited end-receiving (spindle) elements may be part of the housing recess itself (“*formed in...*”), and hence overcomes the Examiner’s rejection.

Claims 60 and 61 – Regarding the Examiner’s rejection with regards to Claim 60, lines 11-13 and Claim 61, lines 11-13, Applicant has amended these claims to correct the insufficient antecedent basis problem. Specifically, Applicant makes it clear that the curling radius of the pre-curved ribbon, i.e. the radius of the curls of the pre-curved ribbon in a relaxed state, is substantially the same as the radius of at least one of the spools.

Regarding, the Examiner’s rejection of Claim 61, lines 14-16, Applicant has deleted the aforementioned claim language, thereby rendering the Examiner’s rejection moot.

Product-by-Process Claims

Claims 39, 40, 44, 45 and 59 – Per page 11 of the Office Action, the Examiner is apparently interpreting Claims 39, 40, 44, 45 and 59 as “product-by-process” claims. Even if, *arguendo*, these claims are properly treated as product-by-process claims, Applicant submits that characterizing them as so in no way affects the patentability of the claims. Per MPEP 2113:

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Therefore, in order for a claim to be unpatentable under an anticipation standard (Section 102), the product claimed and the product of the prior art must be the same, even if the process which makes the product is different. Here, the Examiner is apparently making the assertion that the end-product of Cayer (US Patent No. 4,369,929, hereinafter “Cayer”) is the same as that of Applicant’s Claim 39, 40, 44, 45 and 59 inventions. Applicant traverses this assertion, and believes this argument is wholly without merit. For example, Claim 39 is directed to a *curled*

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ribbon dispensing apparatus. Cayer does disclose “ribbon” of any kind, let alone ribbon that retains its curl after unwinding (see, e.g., Claim 39 limitations of “Curled ribbon dispensing apparatus...”), therefore Applicant is at a loss to understand how the Examiner can characterize the products from these two inventions as the same, as required by MPEP 2113 cited above.

5 **Note also that ribbon is certainly not inherent in “rolled sheet goods” as set forth in Cayer, and Applicant would go so far as to say that by teaching rolled sheet goods, Cayer teaches away from ribbon, since ribbon cannot in any manner be considered a sheet good”, especially in light of Applicant’s recited “helical lay pattern” (i.e., how does one roll a sheet in a helical pattern?)**

10 The Examiner, in responding to Applicant’s arguments, states at page 11 of the Office Action that “*the time at which the ribbon is curled does not structurally distinguish Applicants device over Cayer or modifications of Cayer*”, however Cayer does not even disclose ribbon (a structural as opposed to functional limitation), let alone apparatus for dispensing curled ribbon (also a structural limitation). Applicant cannot understand how this reference could possibly
15 anticipate Applicant’s invention as claimed if it does not disclose at least two structural limitations. Applicant will further discuss the patentability of these individual claims separately below.

§102 Rejections

20 **Claim 40** – Per pages 4-5 of the Office Action, Claim 40 stands rejected under Section 102 as being anticipated by Cayer. Applicant respectfully traverses this rejection in its entirety; in particular, Applicant believes that Cayer neither discloses nor remotely suggests, *inter alia*, “*disposing at least a portion of said ribbon on a substantially elongate spool after said at least portion has been curled*”. On page 5 of the Office Action, the Examiner states that “the material
25 on the spools is pre-curved since it is curled before being dispensed as a result of being wound on the spools”, however this argument is not in any way consistent with the invention Applicant has claimed. The above claim language, in Applicant’s view, clearly conveys to one of ordinary skill that the term “pre-curved” is to be interpreted as the ribbon being curled before being disposed on a substantially elongate spool. **Applicant respectfully requests that the Examiner specifically**

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point to citations within Cayer where it teaches (i) ribbon versus a sheet material, and (ii) disposing at least a portion of said ribbon on a substantially elongate spool after said at least portion has been curled.

On page 5 of the Office Action, the Examiner also appears to be utilizing a product-by-process argument in his rejection of Claim 40 by stating that “*the apparatus disclosed by Cayer is equivalent to that formed by the claimed process.*” Applicant disagrees and traverses; Applicant’s invention dispenses curled ribbon while Cayer dispenses sheets of material that will not be curled upon being dispensed (or are in any way curled before being placed on the spool), the resulting products would not be the same.

Further, not only does Applicant believe that Cayer does not anticipate Applicant’s invention as claimed, there is no suggestion that Cayer ever even contemplated curled materials disposed on a spool, yet alone curled ribbon, or any ribbon for that matter. This is evidenced by Cayer’s disclosure of “*rolls of sheet goods 12-15 [which] may include such items as wax paper, aluminum foil, self-adhering food wrap (Saran™. wrap), plastic bags (Baggies™ food storage bags), and the like.*” See Cayer, Col. 3, lines 37-40. None of these specific items labeled by Cayer would ever need to be curled, or disposed on a substantially elongate spool after being curled. Hence Applicant believes that Applicant’s invention of Claim 40 could not possibly have been contemplated by Cayer. Applicant therefore believes that the Examiner’s characterization that Cayer anticipates Claim 40 is wholly without merit.

Further, Applicant submits that none of the prior art including those specific references cited by the Examiner in rejections of other claims by Applicant including Goldstein (US Pat. No. 5,407,417, hereinafter “Goldstein”); Brown (US Pat. No. 987,952, hereinafter “Brown”); and Schwartz (US Pat. No. 3,948,455, hereinafter “Schwartz”) anticipate or render obvious Applicant’s Claim 40 invention. For example, Applicant submits that Goldstein actually teaches away from Applicant’s invention as Goldstein implements a curling mechanism to curl the ribbon as it is being dispensed from a spool thus teaching away from the concept of disposing at least a portion of said ribbon on a substantially elongate spool after said at least portion has been curled (see e.g., Fig. 1 of Goldstein and its accompanying disclosure). Applicant’s invention has several advantages over the invention contemplated by Goldstein, as Applicant’s invention can

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be implemented in more space efficient packaging and is overall a more cost-effective solution to supplying curled ribbon to a consumer. Applicant's invention also provides a much more consistent conditioning of the ribbon than the apparatus disclosed in Goldstein as Applicant eliminates operator variables that are inherently present in the operation of Goldstein's apparatus.

5 Brown only appears to contemplate disposing "sensitized paper" on a spool and hence does not suggest disposing at least a portion of curled ribbon on a spool after it has been curled. Applicant believes the concept of disposing a pre-curved ribbon would be useless in the context underlying the Brown invention.

Schwartz neither teaches nor suggests, *inter alia*, curling at least a portion of a ribbon.
10 Applicant respectfully submits that Claim 40, and all claims depending directly therefrom is both novel and non-obvious over the prior art, including the prior art of record and hence is in condition for allowance.

Claim 51 – Per page 5 of the Office Action, Claim 51 stands rejected under Section 102
15 as being anticipated by Cayer. Applicant has herein amended Claim 51 to include, *inter alia*, a limitation *wherein said material is curled by a curling mechanism prior to being disposed on said plurality of spools*. Support for this amendment is replete throughout Applicant's specification; specifically support can be found, *inter alia*, at page 4, lines 8-16 of Applicant's specification. For reasons similar to those previously discussed with respect to Cayer, Applicant
20 submits that Cayer does not disclose each and every limitation of Claim 51 as amended, and hence can not as a matter of law anticipate Applicant's Claim 51 invention.

Further, Applicant submits that Claim 51 as amended distinguishes over other prior art, including the specific references cited by the Examiner in this Office Action (i.e., Goldstein, Brown, and Schwartz). Applicant believes that only one of these references relates to curled
25 material, namely Goldstein; however Goldstein curls material only ***after*** the material has been disposed on a spool resulting in bulkier, more expensive packaging, and hence actually teaches away from Applicant's Claim 51 invention. Applicant respectfully submits that Claim 51 as amended and all claims depending directly therefrom are in condition for allowance.

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Claim 59 – Per pages 5-6 of the Office Action, Claim 59 stands rejected under Section 102 as being anticipated by Cayer. Applicant respectfully disagrees and traverses; specifically Applicant does not believe Cayer teaches, *inter alia*, “a plurality of spools of pre-curled ribbon”. Applicant submits that Cayer does not even teach ribbon, let alone pre-curled ribbon and hence
5 as a matter of law can not anticipate Claim 59. Applicant respectfully reminds the Examiner that in order for Cayer to anticipate Applicant’s invention, the cited reference must disclose each and every element and limitation present in Claim 59. See e.g., MPEP 2131.

Further, Applicant submits that simply disposing ribbon on a spool can not fairly be characterized as “pre-curling” ribbon as such an interpretation is clearly inapposite to the plain
10 meaning of the word “pre-curled” in light of the preamble, and other intrinsic evidence to include the entirety of Applicant’s specification. However, Applicant has herein amended Claim 59 to incorporate limitations consistent with those of the preamble of Claim 59 into the body of that Claim, to more clearly describes what Applicant regards as its invention.

Applicant submits that none of the prior art, including Cayer, Goldstein, Brown or
15 Schwartz teaches a “pre-curled ribbon” as it is clearly defined in the claim itself, and hence can not as a matter of law anticipate or render obvious the invention of Claim 59.

§103 Rejections

Claim 28 – Per page 6 of the Office Action, Claim 28 stands rejected under Section 103
20 as being unpatentable over Cayer. Applicant has herein amended Claim 28 to include limitations relating to *spools each having first and second ends, the distal portions of said ends not having any material wound thereon*. Support for Applicant’s amendment can be found, *inter alia*, at Fig. 1a and its accompanying disclosure. Applicant believes that none of the embodiments of
25 Cayer teach or suggest, *inter alia*, the distal portions of the ends not having any material wound thereon (See Figs. 1, 2, 4, 5 and 7 of Cayer), and hence as a matter of law can not be anticipate Claim 28 as amended.

Further, Applicant has also amended Claim 28 to include a limitation wherein said
material is curled by a curling mechanism prior to being disposed on said plurality of spools.

30 Support for Applicant’s amendment can be found, *inter alia*, at page 4, lines 8-16 of Applicant’s

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specification. Applicant submits that none of the prior art, including those specific references cited by the Examiner in this Office Action (i.e., Cayer, Goldstein, Brown and Schwartz) teach or suggest Applicant's Claim 28 invention as amended.

Hence, Claim 28 as amended cannot as a matter of law be rendered obvious by the cited art, since none teaches the aforementioned limitation(s). Applicant therefore respectfully submits that Claim 28 and all claims depending either directly or indirectly therefrom are in condition for allowance.

Claim 39 – Per pages 8-9 of the Office Action, Claim 39 stands rejected under Section 103 as being unpatentable over Cayer in view of Goldstein and Schwartz. Applicant believes that none of these references teaches *a plurality of elongate spools of curled ribbon disposed substantially within said recess, said ribbon wound onto said spools in a substantially helical pattern after at least a portion thereof has been curled*. **Applicant respectfully requests that the Examiner specifically point to citations where any of these references teaches winding ribbon on spools after at least a portion thereof has been curled.** Although Claim 39 does include functional language, Applicant submits this functional language is merely present to help clarify structural terms. In Applicant's view, only one of these references even contemplates curled ribbon (i.e., Goldstein), and Goldstein clearly teaches curling the ribbon **after** the ribbon has been wound onto a spool, not before as in Applicant's claimed invention, thereby *teaching away* from Applicant's claimed invention. Applicant believes this rejection was improper and respectfully submits that Claim 39 is in condition for allowance.

Claim 44 – Per pages 7 and 8 of the Office Action, Claim 44 stands rejected under Section 103 as being unpatentable over Cayer in view of Goldstein. Applicant respectfully disagrees and traverses this rejection, as Applicant believes none of these references teaches, *inter alia*, "curled ribbon". The Examiner is apparently interpreting the term "curled ribbon" to be synonymous with ribbon that is wound on a spool. Applicant believes this interpretation is clearly inapposite to other relevant language within the claim itself, as well as the plain meaning of the term in light of Applicant's disclosure. For example, Claim 44 sets forth in pertinent part:

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“said ribbon having a curl radius determined before winding onto said spools and being wound onto said spools in a substantially helical pattern, said spools having a radius similar to said curl radius.”

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Applicant respectfully submits that interpreting curled ribbon to mean ribbon wound on the spools as is apparently done by the Examiner in his comments at the top of page 8 of the Office Action is improper, especially in light of Applicant’s claim language. Applicant however has herein amended Claim 44 to more clearly and particularly describe what Applicant regards as
10 their invention. Specifically Claim 44 has been amended to delete the word “determined” from the above claim language. Support for Applicant’s amendment is replete throughout Applicant’s specification (see e.g., page 4, lines 8-16 of Applicant’s specification). Applicant believes that the claim language as amended unequivocally conveys that Applicant intends the term “curled ribbon” to be interpreted as ribbon curled prior to being placed onto spools.

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Claim 45 – Per page 8 of the Office Action, Claim 45 stands rejected under Section 103 as being unpatentable over Cayer in view of Goldstein. Applicant respectfully disagrees and traverses this rejection. Specifically Applicant believes that neither Cayer nor Goldstein nor any other prior art references teach or suggest, *inter alia*, a “*plurality of spools of pre-curved ribbon..*” Cayer does not disclose ribbon nor curling while Goldstein teaches curled ribbon, but
20 the ribbon in Goldstein is not *pre-curved*. **Applicant respectfully requests that the Examiner cite to where any of these references teaches a plurality of spools of pre-curved ribbon.** Applicant believes the Examiner is interpreting pre-curved ribbon to mean ribbon wound on spools; however Applicant again contends that such an interpretation is erroneous in light of the
25 claim language and other intrinsic evidence in Applicant’s specification.

For example, Applicant’s amended claim language (the amended language being associated with overcoming the Examiner’s indefiniteness rejection) sets forth that the *radius of said spools further being selected so as to be substantially similar to that of said radius associated with said curl of said pre-curved ribbon before it is placed on said spools*. Applicant

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believes that the Examiner's interpretation is simply not consistent with the invention as described or claimed.

Applicant hence believes Claim 45 and all claims depending either directly or indirectly therefrom distinguish over the prior art and are in condition for allowance.

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Claim 58 – Per page 10 of the Office Action, Claim 58 stands rejected under Section 103 as being unpatentable over Cayer in view of Schwartz. Again, Applicant traverses, and believes the Examiner is ignoring or mis-interpreting the term “pre-curved”. Applicant believes that Cayer does not teach nor remotely suggest “ribbon”, let alone “pre-curved ribbon”. In fact Applicant believes that each of the materials disclosed by Cayer (i.e., *wax paper, aluminum foil, self-adhering food wrap (Saran™ wrap), plastic bags*) would not inherently retain curl after being dispensed, nor would they be “pre-curved”.

Further, Applicant believes that the Examiner's interpretation is inconsistent with the language of the claim as evidenced by the following language of Claim 58 which sets forth in relevant part that *said pre-curved ribbon within said dispenser obviates the need for any curling apparatus on said dispenser*. The Examiner's interpretation apparently is saying the dispenser or at least part of it (i.e., the spool) is the curling apparatus, **an interpretation that totally ignores the aforementioned claim language which says there is no need for a curling apparatus on said dispenser**.

Applicant respectfully submits that the Examiner's rejection was improper because it ignores relevant claim language, and hence Applicant believes that Claim 58 distinguishes over the prior art, including the prior art of record, and is therefore in condition for allowance.

Claims 60 and 61 – Per page 8 of the Office Action, Claims 60 and 61 both stand rejected under Section 103 as being unpatentable over Cayer in view of Goldstein. Although Applicant submits that both of these Claims as previously presented distinguish over the prior art, Applicant has herein amended these claims to further clarify what Applicant regards as its invention. Specifically, Applicant has amended Claims 60 and 61 to include a limitation where *said curling radius [is] the radius of the curls of said pre-curved ribbon in a relaxed state*.

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Support for this amendment can be found, *inter alia*, at page 4, lines 8-16 of Applicant's specification.

Applicant believes that even if, *arguendo*, the term "pre-curled" is interpreted as the Examiner suggests; i.e., having a curl resulting from being wound on the spools (which
5 Applicant believes is an erroneous and highly specious interpretation of Applicant's claim language and specification), the curling radius, if any, would not be substantially the same as the radius of at least one of said spools in a relaxed state. It is well known to those of ordinary skill in this art field that merely winding ribbon on a spool does not impart any significant or lasting curl. Hence, as soon as the non pre-curled ribbon is removed from the spool (i.e., placed in a
10 relaxed state), it effectively loses any curl it might have acquired by virtue of being placed on the spool, and therefore the radii of interest are in no way even remotely close (since the non pre-curled ribbon effectively has an infinite radius of curl).

Applicant therefore submits that Claims 60 and 61 distinguish over the prior art and hence are both in condition for allowance.

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Declarations Under 37 C.F.R. § 1.132

Applicant submits herewith two (2) Declarations Under 37 C.F.R. § 1.132. The first declaration is submitted by Mitchell Truelock, owner of the Assignee of the present application, for purposes of demonstrating the commercial success of the inventions claimed in Claims 39,
20 40, 44, 45, 58, 59, 60, 61 as presented herein. As previously discussed herein, Applicant believes that none of the foregoing Claims are anticipated by any prior art references, and hence are properly addressed by Applicant's submission of a declaration of commercial success under 37 C.F.R. § 1.132. The second declaration by Kim J. Dato, co-inventor of the present application, demonstrates the relationship between the commercially successful embodiment(s) and the
25 foregoing claims as presented. Applicant notes that these declaration must as a matter of law be considered by the Examiner: "[e]vidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." See MPEP Section 716.01(a).

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Hence, Applicant submits that the enclosed Declarations clearly support Applicant's contention that the inventions of these Claims are non-obvious over the art of record.

Other Remarks

5 Applicant hereby specifically reserves all rights of Appeal (including without limitation those under the Pre-Appeal Brief Pilot Program), as well as the right to prosecute claims of different or broader scope in a continuation or divisional application.

10 Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention and responding to the aforementioned restriction election, and not for purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, based on such claim cancellations or additions.

15 Furthermore, any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

If the Examiner has any questions or comments that may be resolved over the telephone, he/she is requested to call the undersigned at (858) 675-1670.

20 Respectfully submitted,

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25 Dated: November 30, 2005

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